

ESTTA Tracking number: **ESTTA625726**

Filing date: **09/08/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91209816
Party	Defendant Solomon Berman
Correspondence Address	BRENDAN M SHORTELL LAMBERT & ASSOCIATES 92 STATE ST STE 200 BOSTON, MA 02109-2004 UNITED STATES shortell@lambertpatentlaw.com
Submission	Opposition/Response to Motion
Filer's Name	Brendan Shortell
Filer's e-mail	shortell@lambertpatentlaw.com
Signature	/Brendan M. Shortell/
Date	09/08/2014
Attachments	Opposition to Extension of Time.pdf(39370 bytes) Ex. 1_Patel Appointment Email.pdf(18457 bytes) Ex. 2 _Burda Withdrawal.pdf(12643 bytes)

**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Quantum Test Prep,)	
)	Opposition No. 91209816
)	Serial No. 85804808
v.)	Mark: QUANTUM PREP
)	
Mr. Solomon Berman,)	
Applicant.)	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

**MR. SOLOMON BERMAN’S OPPOSITION TO QUANTUM TEST PREP’S
MOTION TO EXTEND TRIAL PERIODS**

Mr. Solomon Berman (“Applicant”) hereby opposes Quantum Test Prep’s (“QTP”) motion to extend trial periods, Docket #25, for the reasons set forth below:

QTP is essentially asking for two things under one motion, an extension of the trial period (which is currently ongoing) and a reopening of the July 10, 2014 deadline to produce pretrial disclosures. Applicant will address these two issues separately.

Extension of Trial Periods

From the beginning, QTP has attempted to delay these proceedings, and refused to comply with the deadlines set out by this Board.

Pre-Trial Conference: Failure to Disclosure

During the parties’ pre-trial conference, QTP and Applicant agreed to exchange specimens of first use in the United States in an attempt to resolve this issue before it began, as QTP’s date

of first use in the United States is the central issue of the proceeding. QTP failed to provide these specimens as agreed upon.

Discovery: Delays and Incomplete Disclosures

QTP's continued to ignore and miss deadlines during the discovery period of this case. Applicant served his first set of interrogatories and requests for production of documents on June 28, 2013. Docket #8. QTP, despite Applicant's numerous reminders and good faith attempts to resolve the matter, failed to provide the discovery responses, and on September 4, 2013 Applicant was forced to file a motion to compel their responses. Docket #9. QTP ignored this motion, and not only failed to provide the requested discovery, but also did not even bother to reply to the motion to compel. QTP's willful ignorance of the discovery requests and the motion to compel further forced Applicant to file a follow up motion on October 7, 2013, requesting that the motion to compel be granted due to QTP's ongoing failure to respond and produce the requested discovery. Docket #12. It was not until October 31, 2013, almost 60 days after Applicant's motion, that QTP felt the need to file a response to the motion to compel. Docket #13. QTP's failure to comply with the discovery deadlines resulted in the proceeding being delayed by three months.

Settlement Discussions: Silence and Further Delays

In February, 2014 Applicant's counsel and QTP's prior counsel began discussing settlement. On February 19, 2014, Applicant sent QTP a settlement agreement containing the terms in which QTP and Applicant agreed upon in principle. QTP did not respond to Applicant about the agreement until April 4, 2014. The April 4, 2014 response contained changes that Applicant immediately stated were not agreeable. From that point until now, a total of five months, and seven months since the original agreement was sent, QTP has not gotten back to Applicant about the agreement. The agreement is not complicated, and there are only a few terms not agreed

upon. There is no indication that QTP has or had any intention to settle, as they have ignored all talks for nearly half a year; QTP simply wanted to avoid prosecuting this case. On July 16, 2014, Mr. Patel, QTP's new counsel, did request an additional suspension for settlement talks, which Applicant did not agree to, given the fact QTP had the settlement agreement since February. Exhibit 1. There are no settlement negotiations going on at this point.

Pre-Trial Disclosures: Noncompliance and Further Delay

After the closure of discovery, the next deadline on the docket was for QTP to provide their pretrial disclosures on July 10, 2014. It is now September 8, 2014 and nothing has been produced to Applicant. QTP's withdrawal of their previous counsel on the date of the pretrial disclosures cannot be considered anything but another attempt to delay these proceedings and have an excuse for not producing the disclosures on time.

Attached, as Exhibit 1, is an e-mail from Attorney Mitesh Patel dated July 16, 2014 stating that he has been retained by QTP in this proceeding. This was six days after the disclosures were due, and five weeks before the current motion was filed. QTP, or Mr. Patel, fail to explain why they waited another six weeks to request an extension of time for the trial periods and to reopen the pretrial disclosures deadline. *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Manufacturing Co.*, 55 USPQ2d 1848, 1851 (TTAB 2000) (applicant's motion to extend discovery denied when counsel knew of unavailability of witness a month before, yet delayed until last day to seek an agreement on an extension of time).

Every deadline set out by this Court, or the rules of Civil Procedure, has been missed by QTP. Every single one. The procedural history of this case demonstrate that this request is not for good cause, but simply another attempt by QTP to delay this proceeding.

Reasons to Grant Motion Are Unjustified

QTP's current request for an extension cited two reasons: the appointment of new counsel and the voluminous amount of discovery to review in this case.

Applicant has demonstrated already that QTP's new counsel was retained almost two months ago, and is in fact not newly appointed.

The claim that there is a "voluminous" amount of discovery to review is simply false. No definition of "voluminous" would accurately describe the discovery in this case. To date, Applicant has produced a total of 69 pages of documents in response to QTP's requests to produce, and only one set of interrogatories, with 24 questions, and one set of admissions requests, with 30 requests to admit were sent by QTP to Mr. Berman. There is no way that this volume of discovery can be described as "voluminous." *Instruments SA Inc. v. ASI Instruments Inc.*, 53 USPQ2d 1925, 1927 (TTAB 1999) (cursory or conclusory allegations that were denied unequivocally by the nonmovant and were not otherwise supported by the record did not constitute a showing of good cause).

QTP's given reasons to request a delay do not explain why QTP waited almost sixty (60) days to file this motion, and it certainly does not justify a need for a four month (the sixty that have passed and the sixty requested) extension on top of the six months since discovery closed to prosecute this case. QTP's delay in requesting this extension is either a result of their failure to do their due diligence or is another dilatory act made in bad faith. *Luemme, Inc. v. D. B. Plus Inc.*, 53 USPQ2d 1758, 1760-61 (TTAB 1999) (diligence not shown when movant waits to request more time until the day of the deadline). QTP has had ample time to prosecute this case and has failed to show good cause as to why an extra sixty days is warranted. Every day in which this proceeding is ongoing Applicant, and his company, sit in limbo as to the ability to use, and register their name, further delaying this proceeding puts a large burden upon Applicant.

Concluding Remarks

QTP has the burden to prosecute the claims they set forth in this proceeding, as from the beginning, QTP has done everything possible to avoid this obligation and have acted in bad faith throughout the proceeding. QTP has demonstrated they have no interest in complying with any deadlines in this proceeding, and instead have willfully ignored them, and continued to delay this proceeding. Yet, they have the audacity to ask to extend this proceeding even more. Applicant believes that every action, or more accurately stated, inaction by QTP has been to delay this proceeding. This includes QTP's "desire" to settle this matter.

Reopening Pretrial Disclosures Deadline

QTP's has requested a reopening of the July 10, 2014 pretrial disclosures, and an additional sixty (60) days, to provide Applicant their pretrial disclosures. QTP cites a change of counsel as their reasoning for this request. QTP's motion was filed almost sixty (60) days after the disclosures were due, and fifty-five (55) days after QTP retained new counsel. QTP and their new counsel were aware of the deadline for the pretrial disclosures¹, yet they have decided to wait almost two months to request an extension. QTP provides no explanation as to the sixty day delay in filing this request. QTP's late request appears to be solely for the purpose of delaying this proceedings, even more than it already has, and is clearly made in bad faith.

On Excusable Neglect

Pursuant to Fed. R. Civ. P. 6(b)(1)(B), TMEP 509(1)(b) clearly states that "when an act may or must be done within a specified time, the court may, for good cause, extend the time on motion made after the time has expired if the party failed to act because of *excusable neglect*." TBMP §§ 509.01(b)(1), 534 and 536 (3d ed. 2011), (emph added) This not the situation here, and

¹ QTP's prior counsel stated in their motion to withdrawal that QTP was aware of all upcoming deadlines. Docket #22.

QTP does not even argue that it is. They offer no factual² or legal support for reopening the deadline to submit their pretrial disclosures.

There are four factors to be considered, within the context of all the relevant circumstances, to determine whether a party's neglect of a matter is excusable: (1) the danger of prejudice to the non-moving party; (2) the length of the delay and its potential impact on judicial proceedings; (3) the reason for the delay, including whether it was within the reasonable control of the moving party; and, (4) whether the moving party has acted in good faith. See *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership*, 507 U.S. 380, 395 (1993).

The Board has consistently held that the third factor —the reason for the delay and whether it was within the movant's control — to be of paramount importance. *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997) at 1587 n.7; see also, *Old Nutfield Brewing Co., v. Hudson Valley Brewing Co.*, 65 USPQ2d 1701 (TTAB 2002). Taking each factor into account there is no doubt that QTP's delay cannot be considered excusable neglect, further, there is no question that the paramount factor, number three, weighs squarely against a finding of excusable neglect.

The danger of prejudice upon Applicant, which is the first factor to consider, is very high, as reopening the deadline for filing their pretrial disclosures would subject Applicant to a potential trial deposition. There would be a burdensome amount of time, expense, and other potential negative impacts of having his testimony taken, which Applicant, and other witness associated with Applicant, should not be subject to because of QTP's neglect. Further, Applicant is prejudiced as granting this motion would allow QTP more time, then the sixteen (16) months they already have had, to investigate their claims and find witnesses to take testimony for. All these implications go to the benefit of QTP, the party in which has consistently missed deadlines

² Applicant will address QTP's patently false statement that there is voluminous amounts of discovery and pleadings to go through.

throughout this proceeding, and to the detriment of Applicant. The deadlines are set for a reason, to prevent inequity on either side, allowing QTP to continue to miss these deadlines without consequence creates great inequity and prejudice against Applicant.

As for the second factor, the length of time of the delay, it has been almost two months since the disclosures were due. A reopening of the time to submit pretrial disclosures, and its potential impact on judicial proceedings, would cause another significant delay. A reopening of the deadline and allowing an additional sixty (60) days would total a four month extension, and delay to the proceedings. QTP's dilatory acts have delayed these proceedings substantially already.

The third *Pioneer* factor, i.e. the reason for the delay and whether it was within QTP's control, and the forth factor, whether QTP has acted in good faith, should be looked at together in this case. It is very questionable that QTP's prior counsel elected to withdraw on the night the disclosures were due. *SFW Licensing Corp. v. Di Pardo Packing Ltd.*, 60 USPQ2d 1372, 1373 (TTAB 2001) (attorney's unwarranted and untimely request for permission to withdraw from representation of party viewed as bad faith attempt to obtain an extension of time). *SFW Licensing Corp.* makes it very clear that "a motion to withdraw cannot be used as a subterfuge to obtain an extension that party would otherwise not be entitled to", this is exactly what QTP has be done. *SFW Licensing Corp.* at 174. QTP's prior counsel had the full allotment of time to produce the pretrial disclosures. QTP's prior counsel withdrew at almost 11:00 PM of the day the disclosures, therefore, the fact that they have new counsel should have no bearing on this deadline as they had counsel until the last moment the disclosures were to be produced. Exhibit 2.

Additionally, Mr. Burda's withdrawal motion specifically stated that QTP was aware of all upcoming deadlines, therefore, there is no evidence or reason to believe that QTP was unaware of

the deadline. Applicant believes that the withdrawal motion was filed by QTP in bad faith with dilatory purposes, on the deadline for the disclosures as an attempt to further delay these proceedings and allot QTP additional time. To further evidence that QTP has acted in bad faith is the fact that they retained an attorney on July 16, 2014, but did not file this motion or an appointment of new counsel until six weeks later. Exhibit 1. On July 16, 2014 Applicant made QTP's new counsel aware that the pretrial disclosures were overdue, despite these notifications QTP waited another five weeks to file this motion. QTP provides no explanation for this delay. *SFW Licensing Corp.* at 173. (opposers had not come forward with "detailed facts" required to carry their burden explaining their inaction).

Additionally, as this Board has explained previously in *Pumpkin*:

"[Under] our system of representative litigation, a party must be held accountable for the acts and omissions of its chosen counsel, such that, for purposes of making the "excusable neglect" determination, it is irrelevant that the failure to take the required action was the result of the party's counsel's neglect and not the neglect of the party itself. *Pioneer*, 507 US at 396 (citing *Link v Wabash R. Co.*, 370 US 626 (1962) and *United States v. Boyle*, 469 US 241 (1985)).

43 USPQ2d at 1587.

As this Board has stated previously, it is well settled that a person is by the consequences of the conduct of the party's freely-selected counsel, including both the acts and omissions of counsel. Thus, the argument that the withdrawal of counsel should allow for a missed deadline to be reset is irrelevant, as QTP's previous counsel had the benefit of all the available time to submit pre-trial disclosures to the Applicant, and both failed to do so, as well as failed to request additional time.

Every *Pioneer* factors way against a finding of excusable neglect. The paramount factor, number three, suggests that the failure to file this motion prior to the deadline being missed was done on purpose, in bad faith, to delay these proceedings.

Applicant reiterates that QTP has the burden of prosecuting the claims they set forth, at some point this has to happen. QTP's new counsel has had six weeks to "catch up" on the pleadings and discovery in this case, which are both minimal, no additional time is needed, and QTP has failed to show good cause why it is.

Prayers for Relief

Wherefore, Applicant requests this Board to:

- A. deny QTP's motion to reopen the pretrial disclosures;
- B. deny QTP's motion to extend the trial dates;
- C. keep the current deadlines as previously set; and,
- D. grant any further relief that this Board sees fit.

Dated: September 8, 2014

Respectfully submitted,

Solomon Berman
By its Attorneys,
Lambert & Associates

/s/ Brendan M. Shortell
Brendan M. Shortell, Esq.
LAMBERT & ASSOCIATES
92 State Street, Suite 200
Boston, MA 02109
Tel. No.: (617) 720-0091
Fax. No.: (617) 720-6307

CERTIFICATE OF ELECTRONIC FILING

I HEREBY CERTIFY that this OPPOSITION TO QUANTUM TEST PREP'S MOTION TO EXTEND TRIAL PERIODS was filed electronically with the Trademark Trial and Appeal Board on September 8, 2014.

_____/s/ Brendan M. Shortell_____
Brendan M. Shortell

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and correct copy of this OPPOSITION TO QUANTUM TEST PREP'S MOTION TO EXTEND TRIAL PERIODS was sent via email and first class mail on this day of September 8, 2014 to the Applicant's counsel of record at the following address:

Mitesh Patel
1580 W. El Camino Real, Suite 13
Mountain View, CA. 94040

_____/s/ Brendan M. Shortell_____
Brendan M. Shortell

Brendan Shortell

From: Mitesh Patel <mitesh@legalforcelaw.com>
Sent: Wednesday, July 16, 2014 6:03 PM
To: shortell@lambertpatentlaw.com; Arun Bose
Subject: Berman v. Quantum Test Prep - Opposition No. 91209816

Mr. Shortell,

I have been retained by Quantum Test Prep today in connection with TTAB Proceeding No. 91209816 between our clients.

I understand you were in settlement negotiations and that the matter was in suspension. I would like to set up a time to discuss this matter with you while I get up to speed, perhaps on Friday July 18 if you're available, or sometime early next week.

In the meantime, while I prepare to make an appearance, would you consent to a 30 or 45 day suspension to give me time to get up to speed and so we can discuss the possibility of settlement? I understand there have been some issues about discovery from looking at the docket. Have those matters been settled?

I look forward to working with you on this matter, please let me know if you have any questions.

Regards,

--
--

Mitesh Patel
Attorney

call: 1-650-390-6458

email: mitesh@legalforcelaw.com

connect: <http://www.linkedin.com/pub/mitesh-patel/40/334/732>

ask: <http://www.quora.com/Mitesh-Patel-11>

LegalForce RAPC Worldwide
Professional Law Corporation
1580 W. El Camino Real, Suite 13
Mountain View, CA 94040
United States of America

www.legalforcelaw.com

About LegalForce RAPC Worldwide - LegalForce RAPC Worldwide is a leading general practice law firm serving the diverse needs of individuals, businesses, and institutions worldwide. RAPC Worldwide is a law firm in the LegalForce network. Each LegalForce network firm is an independent law firm authorized and regulated by the State Bar in which it is licensed, and shares the aim of upholding high ethical standards while offering exceptional legal expertise and access with an uncompromising commitment to client needs.

This electronic transmission contains information which is confidential and/or privileged. The information is intended for use only by the individual or entity named above. If you are not the intended recipient (or the employee or agent responsible for delivering this information to the intended recipient), you are hereby notified that any use, dissemination,

distribution, or copying of this communication is prohibited. If you have received this information in error, please notify me by electronic mail and delete all copies of the transmission. Thank you.

Brendan Shortell

From: Douglas Burda <douglas@burda.co>
Sent: Thursday, July 10, 2014 10:46 PM
To: Douglas Burda
Subject: Request to Withdraw as Attorney
Attachments: 91209816 QUANTUM Burda IP Withdrawal.pdf

Please see the attached.

Sincerely,

Douglas B. Burda, Esq.

BURDA IP

Trademark & E-Business Law
1133 6th Avenue, Unit 207
San Diego, CA 92101 USA

douglas@burda.co
Direct. 619 955 8312
Cell/Text. 248 217 0002
Skype. douglas.burda

burda.co

[Click to schedule a meeting with me.](#)

//

The information contained in this e-mail and/or any attachment(s) is confidential, privileged, and/or otherwise protected from disclosure. It is intended for use only by above-named recipients. If you received this e-mail in error, notify the sender and immediately delete the e-mail and any and all attachments. Any disclosure, copying, distribution and/or other use of information received in error is strictly prohibited.

[Make sure your domain name's contact information is private.](#)